

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Shaun JACKSON et al.
Title: INHIBITION OF PHSPHOINOSTIDE 3-DINASE BETA
Appl. No.: 10/522,777
Int'l. Appln. No: PCT/IB03/04177
Int'l. Filing Date: 8/18/2003
Examiner: Unassigned
Art Unit: Unassigned

PETITION UNDER 37 CFR §1.47(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition under 37 CFR 1.47(a) for an application on behalf themselves and Vijaya Kenche, the nonsigning inventor.

I. Requirements for 37 CFR 1.47(a) Application

37 CFR 1.47(a) states as follows:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

According to MPEP 409.03(a), the requirements under 37 CFR 1.47(a) are as follows:

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning

01/25/2006 GFREY1 00000123 10522777

02 FC:1463

200.00 OP

WASH_1516757.1

inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

(B) The application must be accompanied by proof that the nonsigning inventor (1) cannot be found or reached after diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

(C) The last known address of the nonsigning joint inventor must be stated. See MPEP § 409.03(e).

II. Declaration Under 37 CFR 1.63 and 37 CFR 1.64

Concurrently filed with this Petition is a Declaration under Rule 1.63 signed by all of the available inventors, with as signature block for Dr. Vijaya Kenche. According to MPEP a "declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated." Therefore, the concurrently filed Declaration under Rule 1.63 also qualifies as a declaration under Rule 1.64 and applicants have complied with part (A) of MPEP 409.03(a).

III. Proof that the Nonsigning Inventor Refuses to Execute the Applicant Papers

Also filed currently with this document is a sworn Statement of Facts by Dr. Murray Tait, an executive officer of Cerylid Pty. Ltd., a wholly-owned subsidiary of Cerylid Biosciences Limited, which is also the sole owner of the assignee, Kinacia Pty. Ltd. Dr. Tait was present when there was an express oral refusal by Dr. Kenche to sign the application papers. Dr. Tait was also responsible for sending the application papers to Dr. Kenche's last known address.

A sworn Statement of Facts by Dr. Peter Smith, Chief Executive Officer of Cerylid Biosciences is also attached. In this statement, Dr. Smith attests to an express oral refusal by Dr. Kenche to sign the application papers.

By the accompanying Statements of Facts by Drs. Tait and Smith, applicants have complied with part (B) of MPEP 409.03(a).

IV. Last Known Address of Nonsigning Joint Inventor

The last known address of Dr. Kenche is as follows:

Vijaya Kenche
9 Kings Close
Oakleigh East
Victoria 3166, Australia

With informing the PTO of the last known address of Dr. Kenche, applicants have complied with (C) of MPEP 409.03(a).

V. Fee Under 37 CFR 1.17(g)

Applicants attach hereto a fee for \$200 as required by 37 CFR 1.17(g).

VI. Conclusion

Applicants have complied with 37 CFR 1.47(a) and MPEP 409.03(a) and are therefore entitled to an application on behalf of themselves and Dr. Kenche, the nonsigning inventor. A timely examination on the merits is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date

27 January 2006

By



FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768

Atty. Dkt. No. 027524-0122

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Shaun JACKSON et al.
Title: INHIBITION OF PHOSPHODIESTERASE 3-
DINASE BETA
Appl. No.: 10/522,777
Filing Date: 01/31/2005
Examiner: Unassigned
Art Unit: Unassigned

**STATEMENT OF FACTS TO SUPPORT
PETITION UNDER 37 CFR §1.47(a)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Dr. Murray Tait, declare the following:

1. I am Vice President of Drug Discovery of Cerylid Pty Ltd, a wholly-owned subsidiary of Cerylid Biosciences Limited which is also the sole owner of Kinacia Pty. Ltd.
2. All of the joint inventors, except for Dr. Vijaya Kenche, have assigned the captioned application, US Application No. 10/522,777 to Kinacia Pty. Ltd and have executed a Declaration and Power of Attorney, thereby joining in this application.
3. Due to the below facts, I understand that Dr. Kenche is refusing to join in the captioned application.
4. Having identified a current e-mail address for Dr. Kenche (vkenche@unimelb.edu.au), I sent him the (1) Declaration and Power of Attorney and (2) Assignment for the captioned US patent application on October 11, 2005, requesting his signature on both documents. I followed this up on October 13, 2005 by sending him the PDF files of the US specification and the Preliminary Amendment for the captioned application. Having received no reply or confirmation of receipt from Dr. Kenche, I sent another e-mail reminder on October 24, 2005, to which there was also no response.
5. I then followed up again with another e-mail reminder on the morning of November 7, 2005, as a result of which Dr. Kenche called me by telephone at around 2:15 pm

Atty. Dkt. No. 027524-0122

on the same day. He confirmed his receipt of the documents but reiterated that he would not be signing anything until he could get time to study the documents fully and take legal advice on the matter. He indicated that he was extremely busy and did not say when he might be in a position to decide on whether or not to sign. I informed him that the deadline for submission of the completed documents was drawing nearer and that, should he not be in a position to sign in the near future, Kinacia Pty. Ltd would have to proceed with prosecuting the captioned application without him. He remained firm in his position about not signing until he had sought legal advice.

6. On November 17, 2005, more than one month ago, I sent via Advance Couriers (a private courier company), to Dr. Kenche's presently known address: (1) a copy of the captioned application, (2) the preliminary amendment filed on January 31, 2005, (3) a copy of an unexecuted copy of Declaration and Power of Attorney being filed concurrently with this Statement and in response to the Notice of Missing Requirements dated July 20, 2005, and (4) an unexecuted Assignment. The driver's running receipt, attached hereto as EXHIBIT 1, confirms these documents were delivered to Dr. Kenche's presently known address at 3:15 pm on November 17, 2005.

7. Since speaking with Dr. Kenche on November 7, 2005, I have not heard back from him or received any communications from him.

8. I hereby declare that all the statements made herein of my known knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements are so made punishable by fine or imprisonment, or both, under Section 101 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

11 January 2006.
Date

R. Murray Tait
Dr. Murray Tait

Atty. Dkt. No. 027524-0122

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Shaun JACKSON et al.
Title: INHIBITION OF PHSPHOINOSTIDE 3-DINASE BETA
Appl. No.: 10/522,777
Filing Date: 01/31/2005
Examiner: Unassigned
Art Unit: Unassigned

**STATEMENT OF FACTS TO SUPPORT
PETITION UNDER 37 CFR §1.47(a)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Dr. Peter Smith, declare the following:


1. I am Chief Executive Officer of Cerylid Biosciences, the sole owner of Kinacia Pty. Ltd.
2. All of the joint inventors, except for Dr. Vijaya Kenche, have assigned the captioned application, US Application No. 10/522,777 to Kinacia Pty. Ltd and have executed a Declaration and Power of Attorney, thereby joining in this application.
3. Due to the below facts, I understand that Dr. Vijaya Kenche is refusing to join in the captioned application.
4. I heard from Dr. Murray Tait about his sending of (1) a copy of the captioned application, (2) the preliminary amendment filed on January 31, 2005, (3) a copy of an unexecuted copy of Declaration and Power of Attorney being filed concurrently with this Statement and in response to the Notice of Missing Requirements dated July 20, 2005, and (4) an unexecuted Assignment ("the application papers") during the month of October 2005 to Vijaya Kenche for execution.
5. Several days after October 24, 2005, I called Dr. Kenche to at least confirm his receipt of the application papers sent by Dr. Tait. I was unable to speak with Dr. Kenche

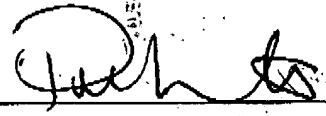
Atty. Dkt. No. 027524-0122

directly, but left him a voice message. Shortly thereafter, Dr. Kenche returned this call (as a voice-mail message) to say he had received the documents, but that he needed time to read and digest them fully before signing.

6. Since receiving this voice mail message from Dr. Kenche, I have not heard back from him or received any communications from him.

7. I hereby declare that all the statements made herein of my known knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements are so made punishable by fine or imprisonment, or both, under Section 101 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

JANUARY
16 - DECEMBER - 2006
Date 


Dr. Peter Smith